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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLINTON D. KNIGHT, KAREN L. MOBLEY and
TIMOTHY ANDREAS MESERTH

Appeal 2008-0472
Application 10/064,292
Technology Center 2100

Decided: June 16, 2008

Before JAMES D. THOMAS, ALLEN R. MACDONALD,
and THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal the Examiner's final rejection of claims 1-16 under 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

A. INVENTION

According to Appellants, the invention is a tooltip corresponding to an object on a display screen that is displayed on the screen in response to a cursor image being positioned over the object. The tooltip continues to be displayed as the cursor moves from the object to the tooltip, and the tooltip is removed from the screen when the cursor moves off both the object and the tooltip. A portion of the tooltip overlaps the object, so that the cursor can be moved from the object to the overlapping portion of the tooltip, and from the overlapping to the non-overlapping portion of the tooltip. A hyperlink may appear in the tooltip, which can be activated by positioning the cursor over the hyperlink in the tooltip and activating a switch or a button on a pointing device, such as a mouse or trackball (Spec., Abstract).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A computer program product embodied in a machine readable media and executable by a processor, said computer program product for use with a computer system having a display screen, a switch, and a pointing device for moving a cursor image on the display screen, said computer program product comprising program instructions for performing the steps of:

displaying an object on the display screen;

displaying a tooltip on the display screen in response to the positioning of the cursor image over the object,

continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Lapidous	US 6,874,126 B1	Mar. 29, 2005 (filed Nov. 30, 2001)
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Claims 1, 3, 5-9, and 14-16 stand rejected under 35 U.S.C. § 102(e) over the teachings of Lapidous; and

Claims 2, 4, and 10-13 stand rejected under 35 U.S.C. § 103(a) over the teachings of Lapidous.

We affirm.

II. ISSUES

The issues are whether Appellants have shown that the Examiner erred in finding that:

(A) Claims 1, 3, 5-9, and 14-16 are unpatentable under 35 U.S.C. § 102(e) over the teachings of Lapidous; and

(B) Claims 2, 4, and 10-13 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Lapidous.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Appellants' Invention

1. In an embodiment of Appellants' invention, upon moving the cursor over object 102, tooltip 105 appears. The tooltip is displayed even when the cursor has moved off object 102 (Spec. 4, para. [0016]-[0017]; figs. 1(b)-(c)).

Lapidous

2. Lapidous discloses display of supplemental content controlled by a cursor position relative to a first predefined region. The method further includes triggering display of an interface element associated with the supplemental content when the cursor is positioned inside the predefined first region, defining a second region that covers at least a portion of the interface element and the current position of the cursor, and continuing the display of the supplemental content upon detecting that the cursor is positioned outside of the first region but within the second region (col. 3, ll. 14-22).
3. Supplement content of tool tip 315 becomes visible when the cursor is positioned inside predefined control region 320, and interface element 345 is also displayed when the cursor is still located in the control region 320. Interface region 335 covers interface element 345 and

cursor position 330 detected at the time interface element 345 becomes visible. The supplemental content remains visible while the cursor is inside the interface region 335, even if the cursor is outside of the predefined control region 320. If the user chooses to interact with the supplemental content of tool tip 315, the user can select interface element 345, causing change in the display of the supplemental content (col. 7, l. 40 to col. 8, l. 3; fig. 3a).

IV. PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

The *claims* measure the invention. See *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). “[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

“[T]he words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). “[T]he ordinary and

customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d at 1313 (Fed. Cir. 2005) (*en banc*).

“‘[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In the absence of separate arguments with respect to claims subject to the same rejection, those claims stand or fall with the claim for which an argument was made. See *In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). See also 37 C.F.R. § 41.37(c)(1)(vii)(2004).

V. ANALYSIS

35 U.S.C. § 102(e)

Appellants do not provide separate arguments with respect to the rejection of independent claims 1 and 9, and claims 3, 5-8, and 14-16 depending therefrom. Therefore, we select independent claim 1 as being representative of the cited claims. Consequently, claims 3, 5-9, and 14-16 fall together with representative claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

As to claim 1, the Appellants argue that Lapidous does not disclose “continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip,” and that “the tooltip (315) in Figure 3A of Lapidous is removed when the cursor of Lapidous moves from the ‘More information’ (325) inside the predefine control region (320) of Lapidous to the tooltip (315) of Lapidous because the cursor of Lapidous would have to move outside of both regions 335 and 320” (Br. 7-8).

We disagree. The claims must be given their broadest reasonable interpretation, and limitations cannot to be read into the claims from the Specification. Appellants’ argument that the teachings of Lapidous differ from the claimed invention because “the cursor of Lapidous would have to move outside of both regions 335 and 320” is not commensurate with the invention that is claimed. That is, Appellants appear to be arguing that the claimed invention continuously displays the tooltip in response to the movement of the cursor from the object to *inside* the tooltip, whereas the tooltip of Lapidous, though it is continuously displayed in response to the movement of the cursor, it is removed when *inside the tooltip* (ie, “*outside of both regions 335 and 320*”), and thus, such argument is not commensurate with the claimed invention.

The Examiner’s position as to Lapidous disclosing the claimed elements on appeal beginning at page 3 of the Answer and the Examiner’s corresponding responsive arguments beginning at page 6 of the Answer meet all of the limitations required by independent claim 1 on appeal.

Lapidous discloses displaying supplement content of tool tip 315 when a cursor is positioned inside predefined control region 320, wherein the display of the supplemental content is continuous even upon detecting that the cursor is positioned outside of the first region but within the second region (FF 2-3). We agree with the Examiner that “the movement of the cursor from the object to the tooltip” of claim 1 “is very broad” and “does not require the cursor to be located inside the tooltip” (Ans. 8). We find the continuous display of the supplement content of tooltip 315 in response to the “movement” of the cursor 330 within predefined control region 320, including “movement” off object 325 to the tooltip 315 while within the region 320 to be “continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip” as recited in claim 1. Appellants’ own disclosure sets forth that upon moving the cursor over object 102, tooltip 105 appears and is displayed even when the cursor has moved off object 102 (FF 1).

Appellants also argue that “Lapidous does not enable each and every element of the claims” because “Lapidous does not disclose each and every element and limitation of claim 1” (App. Br. 9-10). However, as discussed above, the Examiner found that Lapidous discloses the claimed elements on appeal, as set forth beginning at page 3 of the Answer and the Examiner’s corresponding responsive arguments beginning at page 6 of the Answer.

We conclude that the Appellants have not shown that the Examiner erred in rejecting claim 1 as unpatentable over the teachings of Lapidous.

As to the other recited elements of claim 1, Appellants provide no argument to dispute that the Examiner has correctly shown where all these claimed elements appear in the prior art. Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claim 1 as anticipated by Lapidous.

For at least the above reasons, we conclude that Appellants have not shown that the Examiner erred in rejecting claim 1, and claims 3, 5-9, and 14-16 falling with claim 1, under 35 U.S.C. § 102(e).

35 U.S.C. § 103(a)

As to claims 2, 4, and 10-13, Appellants provide the same argument as claims 1 and 9 from which they respectively depend. In particular, Appellants argue “Lapidous does not disclose each and every element of independent claims 1 and 9” (App. Br. 11). However, we see no deficiencies regarding Lapidous, as discussed above regarding claims 1 and 9.

Appellants also argue that the modification of Lapidous does not disclose the limitations of the claimed invention because “the Official Notice taken in the Final Office Action cannot be capable of instant and unquestionable demonstration as well-known in the art” when Lapidous “states that prior art teaches the removal [of] a displayed tool tip from the screen when the cursor moves into the area of the tool tip or exits a screen region associated with a related link or an interface element” (App. Br. 13).

We disagree. Appellants' argument that the modification of Lapidous differs from the claimed invention because Lapidous acknowledges the prior teaching of "removal [of] a displayed tool tip from the screen when the cursor moves into the area of the tool tip" is not commensurate with the invention that is claimed. That is, Appellants appear to be arguing that Lapidous contradicts the teaching of displaying the tooltip in response to the movement of the cursor from the object *into the area of* the tooltip, even though such limitation is not recited in the claims. Moreover, the material at issue in column 2 of Lapidous is stated to be prior art to Lapidous which this reference sets out to improve upon.

The Examiner's position that "it would have been well known in the computer art" that the Lapidous's system suggests a tooltip having overlapping portions and non-overlapping portions beginning at page 5 of the Answer and the Examiner's corresponding responsive arguments beginning at page 7 of the Answer comply with the requirements of the above-noted case law. We find that Appellants' actual claimed invention does not go beyond the reasonable inferences and creative steps that a person of ordinary skill in the art would have employed in light of the teachings of Lapidous. Furthermore, as provided by the Examiner as evidentiary evidence of the assertions, Chithambaram (U.S. Patent No. 7,142,205) discloses that it was well-known to provide "the tooltip having an overlapping portion that overlaps the object on the display screen, and a non-

overlapping portion that does not overlap the object on the display screen” as claimed (Ans. 9).

Therefore, we conclude that Appellants have not shown that the Examiner erred in rejecting claims 2, 4, and 10-13 under 35 U.S.C. § 103(a).

CONCLUSIONS OF LAW

(1) Appellants have not shown that the Examiner erred in finding that claims 1, 3, 5-9, and 14-16 are unpatentable under 35 U.S.C. § 102(e) over the teachings of Lapidous; and

(2) Appellants have not shown that the Examiner erred in finding that claims 2, 4, and 10-13 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Lapidous.

(3) Claims 1-16 are not patentable.

DECISION

The Examiner's rejections of claims 1, 3, 5-9, and 14-16 under 35 U.S.C. § 102(e) and claims 2, 4, and 10-13 under 35 U.S.C. § 103(a) are affirmed.

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Application 10/064,292

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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